

### **REMARKS**

Applicants have received and carefully reviewed the Final Office Action mailed November 19, 2009. Currently, claims 1-2, 4-7, 9-11, 33 and 35-38 remain pending. Claims 1-2, 4-7, 9-11, 33 and 35-38 have been rejected. Favorable consideration of the following remarks is respectfully requested.

#### ***Claim Rejections under 35 U.S.C. § 103***

On page 2 of the Final Office Action, claims 1, 2, 4-7, 9-11, 33 and 35-38 were rejected under 35 U.S.C. §103(a) as being anticipated by Engelson (U.S. Patent No. 5,095,915) in view of Dobak, III et al. (U.S. Patent No. 6,096,068). After careful review, Applicants respectfully traverse this rejection.

Turning to claim 1, which recites:

1. A medical device, comprising:
  - an elongate core member having a longitudinal axis, wherein the core member includes a solid cross-sectional portion having a solid, non-hollow cross-section taken perpendicular to the longitudinal axis;
  - a polymer jacket affixed to at least a portion of the solid cross-sectional portion of the core member, the polymer jacket having a textured outer surface having a first diameter; and
  - wherein the textured outer surface includes a helical groove having a second diameter, less than the first diameter, formed in the outer surface of the polymer jacket, the helical groove defined by one or more rounded edges extending between the first diameter of the outer surface and the second diameter of the helical groove.

The Final Office Action appears to acknowledge that Engelson fails to disclose “the helical groove defined by one or more rounded edges extending between the first diameter of the outer surface and the second diameter of the helical groove”, but turns to Dobak, III et al. for support. Applicants respectfully disagree.

Engelson appears to disclose a guidewire 36 including an elongate wire core 38 having a distal end section encased in an elongate polymeric sleeve 44. As discussed with reference to Figure 9 of Engelson, a helical groove 46 appears to be formed in the sleeve 44 by cutting the sleeve with a blade. (See also column 4, lines 57-61).

Dobak, III et al. appear to disclose a heat transfer element 14 comprised of a series of articulating segments or modules. As can be seen in Figure 5 of Dobak III, et al., a working fluid

appears to be circulated through the heat transfer element 14. Fluid flows up a supply catheter into an insulated inner coaxial lumen 40. At the distal end of the heat transfer element 14, the working fluid exits the inner coaxial lumen 40 and enters an outer lumen 46. While Figure 5 of Dobak, III et al. appears to show an external surface 28 of the heat transfer element 14 as having rounded edges, however, nothing in Dobak, III et al. discloses how to form one or more rounded edges.

More specifically, as noted above, Engelson appears to disclose cutting sleeve 44 to form the helical groove 46. As can be seen in Figure 5 of Dobak, III et al., the external surface 28 appears to have a relatively constant thickness and, as such, does not appear to be formed by cutting the external surface 28. As such, the combination of Engelson and Dobak, III et al. would appear to result in the elongate polymeric sleeve 44 of Engelson being replaced by the external surface member 28 of Dobak, III et al, which does not appear to be formed by cutting. However, Engelson appears to teach away from such a modification, as the elongate polymeric sleeve 44 formed by cutting a helical groove 46 appears to be a general object of the invention of Engelson, which overcomes limitations or problems with prior art flexible tip guidewires. (See column 1, lines 62-65). As such, the asserted modification is improper. (See MPEP § 2145.X.D.2).

Further, it is axiomatic that “because they can be” clearly fails to establish a proper *prima facie* case of obviousness. Under KSR, there must be some reason to make the claimed combination. The Supreme Court in *KSR Int’l Co. v. Teleflex Inc.* quotes *In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006) stated:

“[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness”.

(Emphasis added) (see page 14 of the April 30, 2007 Decision). The Court further stated:

a patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art.

(see page 14 of the April 30, 2007 Decision). It appears that the Office Action has merely found several elements of the claim in the prior art and has made a conclusion of obviousness without any articulated reasoning with some rational underpinning to support the legal conclusion of

obviousness. Applicants submit that the only motivation or reason for combining Engelson and Dobak, III et al. in the manner suggested by the Office Action comes from Applicants' own specification, which is clearly improper. Therefore, for at least these reasons, claim 1 is believed to be patentable over Engelson and Dobak, III et al. For similar reasons and others, claims 2 and 4-5, which depend from claim 1 and which include additional distinguishing features, are believed to be patentable over Engelson and Dobak, III et al.

For similar reasons and others, independent claims 6, 33, and 35 are believed to be patentable over Engelson and Dobak, III et al. For similar reasons and others, claim 7, 9-11, and 36-38, which depend from one of claims 6 and 35 and which include additional distinguishing features, are also believed to be patentable over Engelson and Dobak III, et al.

### ***Conclusion***

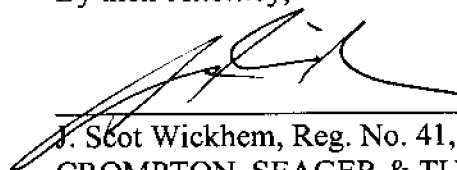
Reconsideration and further examination of the rejections are respectfully requested. It is respectfully submitted that all pending claims are now in condition for allowance. Issuance of a Notice of Allowance in due course is requested. If a telephone conference might be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

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By their Attorney,

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